

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

REMARKS

Claims 1-29 stand rejected under 35 U.S.C. 103(a). Applicants traverse the rejection of the claims.

Independent Claim 1

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

determining a pricing benefit for the transaction based on the pricing activity

Cited portions of Girouard arguably teach "dispensing discount tickets at a customer's request," where the discount tickets "permit a customer to purchase any item in a particular store at a price reduced by a flat rate." However, the cited portions of Girouard do not *determine a pricing benefit for the transaction* - only a benefit for a subsequent transaction.

Other cited portions of Girouard arguably teach "The survey routine starts... When the last question is answered, a coupon or other discount offer is sent to the printer." However, the cited portions do not *determine a pricing benefit based on the pricing activity*. The cited portions show that the benefit is determined regardless of how the pricing activity is performed, instead of *based on the pricing activity* in any way.

Motivation to combine:

The Examiner has alleged that "one would have been motivated to [combine Girouard and Humble] in order to better target the benefit to a product that the customer desires..." However, this proposed motivation is not found in any references of record. Neither Girouard nor Humble suggest a desirability of targeting a benefit to a particular product that a customer desires.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

For instance, Girouard states, "The Mall Promotion Network can dispense coupons at the customer's request (column 4, lines 36-37)." However, this does not at all suggest that a benefit is based on anything in any way, much less based on "a product that the customer desires".

Similarly, Humble does not disclose the desirability of "targeting the benefit to a product that the customer desires". Humble states, for example, "With three customers so characterized, a store manager may wish to identify associated products having some probability of purchase with the three identified products [dog food, yogurt, diet soda]. The manager might associate flea collars with the dog food purchase, vitamins with the yogurt purchase, and low calorie snacks with the diet soda purchase (col 2, lines 62-69)." However, "identifying associated products...with the three identified products" does not suggest targeting a benefit to a product that the customer desires. In contrast, in Humble the store manager hopes that the customer may be convinced to become interested in the associated products - it is not something that the customer already desires, or may ever desire. Humble acknowledges that this is clearly a speculative proposition. Accordingly, Humble does not address "targeting the benefit to a product that the customer desires".

Independent Claim 11

Claim 11 is a product claim which parallels the method of claim 1, discussed above. Accordingly, claim 11 is patentable at least for reasons given for claim 1.

Independent Claim 27

Claim 27 includes the limitation discussed above with respect to claim 1. Accordingly, claim 27 is patentable at least for reasons given for claim 1.

Independent Claim 29

Claim 29 is a product claim which parallels the method of claim 1, discussed above. Accordingly, claim 29 is patentable at least for reasons given for claim 1.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

Claim 2

Claim 2 is a dependent of claim 1. Therefore, claim 2 is patentable for at least the reasons given for claim 1.

Claim 12

Claim 12 is a dependent of claim 11. Therefore, claim 12 is patentable for at least the reasons given for claim 11.

Claim 3

Claim 3 is a dependent of claim 1. Therefore, claim 3 is patentable for at least the reasons given for claim 1.

Additionally, claim 3 is patentable for at least the following reasons:

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

the indication of the at least one product is received by entry of alphanumeric data indicative of the at least one product

Girouard arguably teaches, "[a] computer [that] has a number of associated peripheral devices, including...[a] keyboard..." However, this portion of Girouard does not teach that *the indication of the at least one product is received by entry of alphanumeric data indicative of the at least one product*.

Motivation to combine:

The Examiner alleges that "one would have been motivated to allow the customer to use the keyboard in Girouard to input alphanumeric product data in order to permit products without bar codes, such as fresh produce, to be entered into the system." However, Girouard does not

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

suggest the desirability of entering any products into the system, let alone products without bar codes, and let alone fresh produce.

Claims 5

Claim 5 is a dependent of claim 1. Therefore, claim 5 is patentable at least for reasons given for claim 1.

Claim 6

Claim 6 is a dependent of claim 1. Therefore, claim 6 is patentable at least for reasons given for claim 1.

Claim 8

Claim 8 is a dependent of claim 1. Therefore, claim 8 is patentable at least for reasons given for claim 1.

Claims 9

Claim 9 is a dependent of claim 1. Therefore, claim 9 is patentable at least for reasons given for claim 1.

Additionally, claim 9 is patentable for at least the following reasons:

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

the pricing benefit is a discount on the transaction

The cited portion of Girouard arguably teaches that "The Mall Promotion Network can issue discount tickets at a customer's request. These discount tickets typically permit a customer to purchase any item in a particular store at a price reduced by a flat percentage." However, a

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

discount coupon does not provide any benefit to the transaction, but only for some possible future transaction, which may never occur.

Claim 10

Claim 10 is a dependent of claim 1. Therefore, claim 10 is patentable at least for reasons given for claim 1.

Additionally, claim 10 is patentable for at least the following reasons:

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

the pricing benefit is a discount on the at least one product

The cited portion of Girouard arguably teaches that "The Mall Promotion Network can issue discount tickets at a customer's request. These discount tickets typically permit a customer to purchase any item in a particular store at a price reduced by a flat percentage." However, the cited portions of Girouard do not *determine a pricing benefit on the at least one product [to be included in a transaction]*.

Claims 13

Claim 13 is a dependent of claim 11. Therefore, claim 13 is patentable at least for reasons given for claim 11.

Claim 14

Claim 14 is a dependent of claim 11. Therefore, claim 14 is patentable at least for reasons given for claim 11.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058Claim 15

Claim 15 is a dependent of claim 11. Therefore, claim 15 is patentable at least for reasons given for claim 11.

Independent Claim 16

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

an enclosure including means for allowing a customer to be seated in the enclosure

Girouard arguably teaches a "kiosk" (column 4, line 11). The Examiner has alleged that Girouard and Humble describe an "enclosure". However, there is no mention of an enclosure in Girouard and Humble.

The Examiner has not alleged any reason why the kiosk of Girouard would include an enclosure.

Motivation to combine:

The Examiner has alleged that "one would have been motivated to include [an opposing seat] in order to facilitate the kiosk's use by physically handicapped customers, i.e. those who cannot stand at an upright kiosk for long periods of time..." However, neither Girouard nor Humble has suggested any desirability of accommodating physically handicapped customers. Further, neither Girouard nor Humble has suggested accommodating any customer who would have to stand for a long period of time.

Claim 20

Claim 20 is a dependent of claim 16. Therefore, claim 20 is patentable at least for reasons given for claim 16.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

Additionally, claim 20 is patentable for at least the following reasons:

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

the enclosure includes an entrance, and privacy means for selectively covering the entrance.

The Examiner has taken Official notice that "[an] enclosure including seating for the customer and privacy means covering the entrance...is old and well known in the marketing arts." Applicants respectfully request a reference to support this assertion, per MPEP 2144.03.

Motivation to combine:

The Examiner has alleged that "one would have been motivated to include [an entrance and a curtain] in order to... to provide a degree of privacy when the customer is scanning in products which may cause embarrassment to some." However, neither Girouard nor Humble has suggested any desirability for privacy, let alone any desirability for privacy when scanning products, and let alone any desirability for privacy when scanning products that may cause embarrassment.

Claim 17

Claim 17 is a dependent of claim 16. Therefore, claim 17 is patentable at least for reasons given for claim 16.

Claims 18

Claim 18 is a dependent of claim 17. Therefore, claim 18 is patentable at least for reasons given for claim 17.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

Claim 25

Claim 25 is a dependent of claim 16. Therefore, claim 25 is patentable at least for reasons given for claim 16.

Claim 19

Claim 19 is a dependent of claim 16. Therefore, claim 19 is patentable at least for reasons given for claim 16.

Additionally, claim 19 is patentable for at least the following reasons:

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

means for storing products selected for purchase by the customer

The cited portion of Girouard arguably teaches a "[means for storing data, the data taking the form of an] item list." However, storing data has nothing to do with storing actual products (e.g., a storage bin), as is described in the present specification.

Claim 21

Claim 21 is a dependent of claim 16. Therefore, claim 21 is patentable at least for reasons given for claim 16.

Claims 23

Claim 23 is a dependent of claim 16. Therefore, claim 23 is patentable at least for reasons given for claim 16.

Claim 24

Claim 24 is a dependent of claim 23. Therefore, claim 24 is patentable at least for reasons given for claim 23.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058Claim 26

Claim 26 is a dependent of claim 16. Therefore, claim 26 is patentable at least for reasons given for claim 16.

Claims 7

Claim 7 is a dependent of claim 1. Therefore, claim 7 is patentable at least for reasons given for claim 1.

Claim 22

Claim 22 is a dependent of claim 21. Therefore, claim 22 is patentable at least for reasons given for claim 21.

Additionally, claim 22 is patentable for at least the following reasons:

Motivation to combine:

The Examiner has alleged that it would have been obvious to "send the benefit in Girouard to the POS terminal of the retailer who offered the benefit." The Examiner has further alleged, "One would have been motivated to send the benefit directly to the POS terminal in order to eliminate the need to print the coupon as discussed by Off." Applicants respectfully disagree since no reference suggests sending anything to a POS terminal.

Off states in col 4, lines 34-36, "In accordance with the present invention, at least one of the checkout terminals 12 has associated with it a coupon printer 24" Further, Off describes in several places the printing of coupons. For example, "...the system of the present invention includes ... a means for automatically printing at least one discount coupon (col 2, lines 39-53)."

Presumably, the system of Off lies in close proximity to a checkout terminal, else a customer who has or is checking out would not readily be able to obtain the printed coupons. Although the Examiner has cited an embodiment in which coupons are not printed, Off suggests no different or alternate configuration for embodiments in which coupons are not printed.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058

In contrast to Off, Girouard has neither disclosed nor suggested that the system is intended to lie in proximity to a POS terminal. For example, "These customers would bring the cards to the Mall Promotion Network kiosk located at a mall...(col 4, lines 10-11)". A system located somewhere in a mall would not necessarily be close to a POS terminal.

It follows that there would not be a motivation to combine the systems of Off and Girouard, as Off's system is intended be close to a POS, while Girouard's is not.

Independent Claim 28

Limitations:

The Examiner has not shown that any of the prior art of record discloses the following claim limitation:

determining a discounted price for the transaction based on the pricing activity

The cited portion of Humble arguably teaches "the customer first selecting a first product (col 2, lines 33-36) and then a benefit (coupon) being determined for the selected product (col 2, lines 41-53)." However, nowhere does Humble suggest "determining a discounted price for [a] transaction [which includes a product about which an indication has been received]." Rather, Humble describes coupons which may apply to "associated products having some probability of purchase with the three identified products [i.e. dog food, yogurt, diet soda] (col 2, lines 62-65)."

At best, this coupon would be for a speculative future purchase which the customer might never make (e.g., because the coupon is for an undesired product).

Claim 4

Claim 4 is a dependent of claim 1. Therefore, claim 4 is patentable at least for reasons given for claim 1.

*PATENT*Application Serial No.: 09/672,066
Attorney Docket No: 00-058

In addition, the Examiner has provided only an unsupported allegation of a prior use. This does not rise to the level of substantial evidence. Applicants request a reference as support for the allegations used as a basis for rejection.

PATENT

Application Serial No.: 09/672,066
Attorney Docket No: 00-058**Conclusion**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Geoffrey M. Gelman at telephone number (203) 461-7331 or via electronic mail at ggelman@walkerdigital.com.

Petition for Extension of Time to Respond

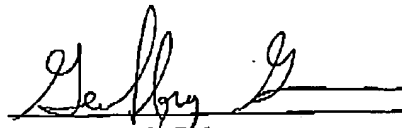
Applicants hereby petition for a **two-month** extension of time with which to respond to the Office Action. Please charge **\$210.00** for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

Please charge as follows:

Charge:	\$210.00
Deposit Account:	50-0271
Order No.	00-058

Charge any additional fees or credit any overpayment to the same account.
A duplicate copy of this authorization is enclosed for such purposes.

Respectfully submitted,



Geoffrey M. Gelman
Agent for Applicants
Registration No. 51,727
ggelman@walkerdigital.com
(203) 461-7331 / voice
(203) 461-7300 / fax

March 17, 2004